



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,425	10/16/2003	Nardo B. Catahan JR.	OIC0242US	2230
60/975 7590 02/11/2009 CAMPBELL STEPHENSON LLP 11401 CENTURY OAKS TERRACE BLDG. H, SUITE 250 AUSTIN, TX 78758				
EXAMINER				
DANNEMAN, PAUL				
ART UNIT		PAPER NUMBER		
3627				
MAIL DATE		DELIVERY MODE		
02/11/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/688,425

Applicant(s)

CATAHAN ET AL.

Examiner

PAUL DANNEMAN

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-18, 20-24, 27 and 28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-18, 20-24, 27 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 December 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This action is in reply to Applicant's response, filed 16 December 2008, to the first office action.
2. Claims 7, 19, 25 and 26 have been cancelled.
3. Claims 1-6, 8-13, 17-18, 20, 22 and 27 have been amended.
4. Pending Claims 1-6, 8-18, 20-25 and 27-28 have been examined in this application.
5. The **Amendment to the Specification** was not entered as it contains duplicate statements beginning with the following excerpt *"present may be provided as a computer..."*

Response to Arguments

6. Applicant has filed a corrected set of drawings in compliance with 37 CFS 1.121(d), therefore the Examiner respectfully withdraws the objection to the drawings.
7. Applicant argues with respect to the Double Patenting rejection *"The Office Action states that claims 1-28 are drawn to identical subject matter as those of Application Serial Number 10/688,094. Office Action, p. 2. Applicants respectfully submit that the claims herein are patentably distinct from those of application number 10/688,094. Applicants respectfully submit that claim amendments presented herein further clarify that the claims of two applications are patentably distinct. For example, claims 1-28 are directed toward invoice information and various elements related thereto, while the claims in 10/688,094 are directed towards invoice adjustment information. The distinction between invoice information and invoice adjustment information is reflected at least in the differences between the specifications of the two applications. For example, the specifications disclose that the two types of information include different essential elements. Furthermore, these differences are reflected in the claims. Claims 1-28 contain limitations not found in the claims of 10/688,094."* The Examiner has carefully reviewed Applicant's Argument and MPEP 804.03 [R-3] I. DOUBLE PATENTING. Claims in commonly owned applications of different inventive entities may be rejected on the ground of double patenting. This is in accordance with

existing case law and prevents an organization from obtaining two or more patents with different expiration dates covering nearly identical subject matter. See *In re Zickendraht*, 319 F.2d 225, 138 USPQ 22 (CCPA 1963) (the doctrine is well established that claims in different applications need to be more than merely different in form or content and that patentable distinction must exist to entitle applicants to a second patent) and *In re Christensen*, 330 F.2d 652, 141 USPQ 295 (CCPA 1964). Therefore, the Double Patenting rejection is maintained.

8. Applicant has amended **Claims 1-6, 8 and 9** in an attempt to overcome the 35 U.S.C. § 101 rejection, however a mere recitation of a ***"computer-implemented method"*** in the preamble of a claim is not sufficient to overcome the 35 U.S.C. S 101 rejection. Therefore, the rejection is maintained on Claims 1-6, 8 and 9.

9. Applicant has amended **Claims 10-12** to recite a ***"the data structure is stored on the machine-readable storage medium,"*** to overcome a 35 U.S.C. § 101 rejection, therefore the rejection of Claims 10-12 under 35 U.S.C. § 101 is respectfully withdrawn.

10. Applicant's arguments regarding the rejection of **Claims 1-28** under 35 U.S.C. § 103(a) have been carefully considered, but the arguments are moot as they are directed to the amended claims.

Double Patenting

11. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

12. **Claims 1-6, 8-18, 20-24 and 27-28** are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of **claims 1-28** of copending Application No. **10/688,094**. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

13. **Claims 1-6, 8-18, 20-24 and 27-28** directed to the same invention as that of **claims 1-28** of commonly assigned **10/688,094**. The issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved.

Since the U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300), the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this situation since the basis for refusing more than one patent is priority of invention under 35 U.S.C. 102(f) or (g) and not an extension of monopoly.

Failure to comply with this requirement will result in a holding of abandonment of this application.

Claim Rejections - 35 USC § 101

14. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

15. **Claims 1-6, 8 and 9** are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes

the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101.

Claim Rejections - 35 USC § 103

16. **Claims 1-6, 8-18, 20-24 and 27-28** are rejected under 35 U.S.C. 103(a) as being unpatentable over Knauss et al., US 7,043,687 B2 hereafter know as Knauss.

As per Claims 1-6, 8-18, 20-24 and 27-28, Knauss in at least FIG.3, Column 5, lines 64-67, and Column 6, lines 1-12 discloses a virtual document interface between applications and various types of messages or documents. Each application has a link to the virtual document interface, in which previously-defined mappings to variables of the virtual document are utilized in order to populate a target document or message, from a source document or message. Knauss in at least Column 6, lines 13-20 further discloses a system and method enabling automatic translation of EDI data to or from a self-describing markup language format such as XML, or an XML dialect, by way of a virtual document. Knauss in at least Column 5, lines 38-48 still further discloses that an EDI message is a data element and may be an invoice or purchase order. Each data element may represent a singular fact, such as a price, product, model number, and so forth.

Knauss in at least FIG.4 and Column 6, lines 36-51 further discloses links or mappings to the variables of a virtual document and to and from the source data model and the target data model.

Knauss in at least Column 9, lines 48-58 and Column 10, lines 1-3 further discloses that under control of the translator, values are written into the variables of the virtual document from the source data model in a data stream from the source data model to the target data model. Knauss in at least Column 9, lines

59-67 still further discloses that multiple target documents may be populated using data obtained from a single source document. Therefore, it would have been obvious, at the time of the invention, to one of ordinary skill in the art to modify Knauss's virtual document interface to map particular data elements of an invoice (i.e. identification data, base data, pricing data, shipping data, and line item details data) with the motivation of providing data in a standard format which is useable by other business applications.

Conclusion

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL DANNEMAN whose telephone number is (571)270-1863. The examiner can normally be reached on Mon.-Thurs. 6AM-5PM Fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul Danneman/

Examiner, Art Unit 3627

7 February 2009

/F. Ryan Zeender/

Supervisory Patent Examiner, Art Unit 3627